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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,689	10/13/2000	William J. Bussick	0112300/474	7705

29159 7590 05/30/2002

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EXAMINER
JONES, SCOTT E

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 05/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/687,689	BUSSICK ET AL.	
	Examiner	Art Unit	
	Scott E. Jones	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 February 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10,12,13,15,17,19-23 and 25-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *17,19-23 and 27-30* is/are allowed.

6)☒ Claim(s) *1-5,7-10,15,25,26 and 31-36* is/are rejected.

7)☒ Claim(s) *6,12 and 13* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *13 October 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *7* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on February 26, 2002 in which Applicant amends the specification, cancels claims 11, 14, 16, 18, and 24, amends claims 1-10, 12, 13, 15, 17, 19-23, adds new claims 25-36, and responds to the claim rejections.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 35 recites the limitation "the other non-wild symbols" in lines 9-10. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1, 2, 4, 5, 9, 10, 15, and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Nagano.

Nagano (U.S. 6,299,165) discloses a gaming machine and method for a plurality of payouts for normal hits, double times odds hit with a wild symbol, or four times odds hit with two wild symbols. Anytime a wild symbol appears on the payline, then the wild symbol is replaced by another symbol. A player can receive additional payouts if the new combination contains either a normal hit, or a hit having another wild card. Nagano additionally discloses:

Regarding Claims 1 and 31:

- maintain a list of award-yielding symbol combinations of the plurality of symbols in the controller (Figure 3);
- randomly generating a first set of the symbols from the plurality of symbols (Figure 5, and Column 6, lines 31-65);
- providing an award for each award-yielding symbol combination appearing in the first set (Figure 5, and Column 6, lines 31-65);
- selecting at least one but not all of the symbols in the first set for individual replacement and individually replacing each said selected symbol in the first set with one of the plurality of symbols to generate a second set of the symbols (Column 6, line 66-Column 7, line 55);
- providing an award for each award-yielding symbol combination appearing in the second set regardless of whether the award yielding symbol combination in the

second set appeared in the first set (Figure 6, Column 6, line 46-Column 7, line 5).

Regarding Claim 2:

- the step of selecting at least one but not all of the symbols in the first set for individual replacement includes selecting at least one predetermined symbol for individual replacement (Column 6, line 66-Column 7, line 55). The wild card symbol is replaced in Nagano.

Regarding Claim 4:

- the gaming device is a slot machine having a plurality of reels, the symbols are on the plurality of reels and the step of individually replacing the symbols includes individually replacing the selected symbols without spinning the reels (Column 7, lines 1-11). If a winning symbol combination having a wild symbol occurs, then the reel having the wild symbol is rotated one rotation for the next symbol combination on the reels. Therefore, the reel is rotated one space rather than re-spinning the reel.

Regarding Claim 5:

- the gaming device is a slot machine and wherein generating the first set of symbols includes generating symbols from the plurality of symbols on at least one payline (Figures 1, 3, 5, Column 4, line 54-Column 5, line 17, Column 6, line 46-Column 7, line 55, and Column 8, lines 32-43).

Regarding Claims 9, and 15:

- the step of replacing each selected symbol in the first set includes substituting a wild symbol for at least one selected symbol in the first set, and wherein each wild symbol functions as one of the plurality of symbols (Figure 6, Column 6, line 46-Column 7, line 55). A wild symbol can be replaced with another wild symbol when the reel is rotated.

Regarding Claim 10:

- the step of replacing each selected symbol of the first set includes substituting a wild symbol for at least two selected symbols in the first set, and wherein each said wild symbol sequentially functions as at least one of the plurality of symbols (Figure 6, Column 6, line 46-Column 7, line 55). If two wild symbols appear on the payline, then each could be replaced with wild symbols when each reel is rotated.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 3, 7, 8, 33, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagano in view of Bennett.

Nagano (U.S. 6,299,165) discloses that as discussed above with respect to claims 1, 2, 4, 5, 9, 10, 15, and 31. However, Nagano seems to lack explicitly disclosing:

Regarding Claim 3:

- the step of individually replacing the symbols includes an animation of the symbols which are replaced.

Regarding Claim 7:

- generating the first set of symbols and second set of symbols is part of a bonus game.

Regarding claims 8, 33, and 36:

- the symbols are playing cards.

Bennett (U.S. 6,089,977) teaches of a slot machine having a base game along with a roaming wild card bonus feature which moves around the screen replacing each symbol in the display and a prize is awarded for winning combinations created while the wild card is positioned at each location. Bennett also teaches:

Regarding Claim 3:

- the step of individually replacing the symbols includes an animation of the symbols which are replaced (Abstract, Column 1, line 61-Column 2, line 30). The wild card (penguin) animates as it moves along a path on the screen replacing each symbol.

Regarding Claim 7:

- generating the first set of symbols and second set of symbols is part of a bonus game (Abstract, Column 1, line 61-Column 2, line 30). The first set of symbols triggers the bonus game (Iceberg anywhere on reel 1 and background coin anywhere on reel 5). A different set of symbols are then generated each time the wild card (penguin) moves along a path to another reel position.

Regarding claims 8, 33, and 36:

- the symbols are playing cards (Abstract, Figure 2, Column 1, line 61-Column 2, line 30, and Column 5, lines 44-52).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to utilize the wild card replacement feature of Bennett in Nagano. Doing so would enable casino operators to offer a game(s) which is popular with players because a player perceives the wild card animation feature as giving a player a greater chance of winning keeping a player's interest in a game, and as a mechanism for improving sales for the casino.

9. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagano in view of Vuong et al. (U.S. 5,762,552).

Nagano (U.S. 6,299,165) discloses that as discussed above with respect to claims 1, 2, 4, 5, 9, 10, 15, and 31. However, Nagano seems to lack explicitly disclosing operating the gaming machine over a data network, such as, the Internet (Claims 25 and 26).

Vuong et al. (U.S. 5,762,552) teaches of an interactive real-time network gaming system that can be implemented on a real-time network (Summary of the Invention). Vuong et al. also teaches that a player can gamble on-line via the Internet (Background of the Invention). It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate the network gaming features of Vuong et al. in Nagano. Doing so would enable the gaming operator to provide a system where a player could simultaneously participate in more than one game of chance so as to further increase casino revenue.

Allowable Subject Matter

10. Claims 17, 19, 20, 21, 22, 23, 27, 28, 29, and 30 are allowed.

11. Claims 6, 12, and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

12. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Friday, 8:30 A.M. - 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (703) 308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Scott E. Jones
Examiner
Art Unit 3713

SEJ
sej
May 21, 2002

V. Martin-Wallace

VALENCIA MARTIN-WALLACE
SUPERVISORY PATENT EXAMINER
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